

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
Andrew H. Pritchard	)	
Application No:	)	Art Unit: 3624
09/927,628	)	
Filed: August 10, 2001	)	Confirmation No.: 5363
For: SYSTEMS AND METHODS FOR	)	Examiner: Olabode Akintola
DEVELOPING AND	)	
ADMINISTERING INVESTMENT	)	
TRUSTS	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION FOR EXTENSION OF TIME**

Pursuant to 37 C.F.R. § 1.136(a), we hereby petition for a one-month extension of time to respond to the Office Action dated May 1, 2007.

The Commissioner of Patents is hereby authorized to charge Deposit Account No. 50-3938 in the amount of \$ 120.00 in connection with the petition for extension of time. The Commissioner of Patents is hereby authorized to charge payment of any additional filing fees required under 37 C.F.R. § 1.17 in connection with the present application, or credit any overpayment of same to Deposit Account No. 50-3938.

**REPLY TO FINAL OFFICE ACTION**

In response to the Office Action mailed May 1, 2007, please amend the above-identified application as follows.

**Amendments to the Claims** are reflected in the listing of claims which begins on page **2** of this paper.

**Remarks** begin on page **6** of this paper.

**In the Claims:**

1. (Currently Amended) A method ~~for developing and administering investment trusts~~ comprising:  
receiving at least one risk/return preference associated with an user;  
selecting, on behalf of the user, an investment instrument from a plurality of available investment instruments, in which the act of selecting is based on a profile associated with a user's preferences at least one risk/return preference of the user;  
creating storing an investment trust with the selected investment instrument in an investment trust, in which the investment trust comprises a plurality of selected investment instruments and is traded as a single security on an exchange;  
transmitting a request to trade at least one share of trading the investment trust on a financial exchange to provide an ownership interest in the investment trust, in which the at least one share corresponds to an ownership interest in a percentage of each selected investment instrument of the investment trust;  
receiving a request to redeem the at least one share for a corresponding ownership interest in the investment trust; and  
transmitting a value associated with the corresponding ownership interest.  
~~redeeming the ownership interest in the investment trust for at least the investment instrument.~~
2. (Currently Amended) The method of claim 1, further comprising ~~creating~~ generating a database of investment instruments that is available for selection.
3. (Cancelled).
4. (Currently Amended) The method of claim 1, further comprising:  
tracking determining the a plurality of value-values of associated with the investment instrument at a plurality of times; and

storing the plurality of values ~~tracked investment instrument~~ in a database.

5. (Currently Amended) The method of claim 4, ~~further comprising in which the act of selecting the investment instrument is based on the plurality of values stored~~ storing value information related to the tracked investment instrument in a the database.

6. (Currently Amended) The method of claim 1, further comprising  
receiving a request for a financial report;  
generating [[a]] the financial report; and  
transmitting the financial report to the user.

7. (Currently Amended) The method of claim 1, further comprising:  
determining ~~whether that~~ the investment instrument ~~expires~~ has expired; and  
replacing the expired investment instrument with a similar second investment instrument ~~when the investment instrument expires~~, in which the second investment instrument comprises a risk/return ratio that is similar to a risk/return ratio associated with the expired investment instrument.

8-16. (Cancelled).

17. (New) The method of claim 1, in which the investment instruments further comprises at least one of:

a stock, a bond, a debt instrument, an exchange traded-fund, a mutual fund, a currency, a commodity, an equity investment, a futures investment, a dividend-paying investment, and any other suitable asset.

18. (New) The method of claim 1, in which the risk/return preference comprises at least one of:

a growth in equity that is selected by the user, a rate of return that is selected by the user and a level of risk that is selected by the user.

20. (New) The method of claim 1, in which the act of selecting the investment instrument further comprises at least one of:

determining that a growth in equity of the investment instrument is greater than the growth in equity selected by the user;

determining that a rate of return of the investment instrument is greater than the rate of return that is selected by the user;

determining that a level of risk of the investment instrument is less than a level of risk selected by the user;

determining that a growth in equity of the investment instrument is greater than the growth in equity provided by each of the plurality of investment instruments;

determining that a return in yield of the investment instrument is greater than the return in yield provided by each of the plurality of investment instruments; and

determining that a level of risk of the investment instrument is less than the level of risk selected by the user.

21. (New) An apparatus comprising:

a processor; and

a memory, in which the memory stores instructions which, when executed by the processor, direct the processor to perform the method of claim 1.

22. (New) The apparatus of claim 21, in which the processor further performs the method of claim 2.

23. (New) The apparatus of claim 21, in which the processor further performs the method of claim 3.

24. (New) The apparatus of claim 21, in which the processor further performs the method of claim 4.

25. (New) The apparatus of claim 24, in which the act of selecting the investment instrument is based on the plurality of values stored in the database.

26. (New) The apparatus of claim 21, in which the processor further performs the method of claim 6.

27. (New) The apparatus of claim 21, in which the processor further performs the method of claim 7.

## **REMARKS**

### **A. Status of the Application**

- Claims 1, 2, 4 to 7 and 17 to 27 are pending in the application, of which claims 1 and 9 are independent claims.
- Claims 1, 2 and 4 to 7 are amended.
- Claims 3 and 8 to 16 are cancelled.
- Claims 17 to 27 are new claims. No new matter has been added.

Accordingly, entry of the amendments and the new claims is respectfully requested. Applicants have amended the claims to recite particular embodiments that Applicants, in their business judgment, have determined to be commercially desirable at this time. The claim amendments have not been submitted for any reasons relating to patentability, such as to overcome any of the Office Action's rejections.

Applicants intend to pursue the subject matter of the previously withdrawn and previously cancelled claims, in one or more continuing applications.

### **B. Claim Rejection Under 35 U.S.C. § 103**

The Office Action rejected claim 1 under 35 U.S.C. § 103 as allegedly unpatentable over U.S. Patent No. 5,946,667 ("Tull") in view of U.S. Patent No. 6,601,044 ("Wallman"). Applicant traverses. The Office Action has not made a *prima facie* showing that any of Applicant's claims are obvious.

1. Certain Limitations Are Not Disclosed in Tull and Wallman

Claim 1 recites, *inter alia*, “selecting, *on behalf of the user*, an investment instrument... in which the act of selecting is based on at least one risk/return preference of the user” (emphasis added).

Neither the Tull nor Wallman references teach or suggest “*selecting, on behalf of the user, an investment instrument.*” Instead, Tull recites that “[t]he basket of shares underlying the debt instrument of the present invention is *selected through a mathematical programming function*” (col. 3, lines 63-65). Tull’s programming function then “*suggests* a basket of stock shares which are optimally selected to track the investment return of the capital market over a predetermined period of time” (col. 3, line 67 to col. 4, line 3).

Similarly, Wallman describes a “system [that] will *recommend or suggest* to the investor the securities that should be included in the investor’s portfolio that satisfy the investor’s risk and return selections” (col. 14, lines 44-48).

Therefore, the Office Action has failed to state a *prima facie* case of obviousness for claim 1. When a claim recites a limitation that is absent from the art, the claim is not obvious. MPEP §2143.03; *Motorola v. Interdigital Technology Corp.*, 121 F.3d 1461, 1466-67, 43 USPQ2d 1490, 1490-91 (Fed. Cir. 1997) (reversing a jury verdict of obviousness because an element was not taught in the particular art relied upon, even though that element was known elsewhere).

Moreover, the Office Action’s §103 rejections are moot in light of Applicant’s amendments to the claims, which are made for separate reasons. Reconsideration and withdrawal of the rejections are respectfully requested.

2. There is No Substantial Evidence of Motivation to Combine and No Reasonable Expectation of Success

The alleged motivation proffered by the Office Action for combining Tull and Wallman has absolutely no basis in the references themselves. Moreover, the Office Action fails to provide any methodology for practically and realistically applying any features of Tull to modify Wallman. Instead, the Office Action merely states on page 3:

Wallman in the same field of endeavor teaches selecting investment instrument based on a profile associated with an user's preferences. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tull to include the feature as taught by Wallman. One would have been motivated to do so in order to ensure that the selected instrument satisfy the inventor's risk and return selection or other preferences that investor may have.

First, the Office Action inaccurately states that Wallman teaches the feature: "selecting [sic] investment instrument based on a profile with an user's preferences." In actuality, Wallman merely recites "moving a slide or other indicator on the graphical investor interface, and by so doing, change the requested risk and return levels for the investor's preferred portfolio" (col. 4, lines 33-36).

Second, the motivation proffered by the Office Action is not tenable. As described above, Tull teaches that "the basket of shares underlying the debt instrument is selected through a mathematical programming function" (col. 3, lines 63-64). As such, Tull's invention "provides investors with a convenient, cost effective and mathematically rigorous means of reducing the level of uncertainty about their investment return" (col. 4, lines 4-6). Thus, a person of ordinary skill in the art would not have been motivated to modify Tull with Wallman's moving slides and/or indicators, since doing so would interfere with the mathematical integrity of Tull's programming functions.

Furthermore, the Office Action is silent with respect to reasonable expectation of success—an element required for the showing of any obviousness rejection. MPEP



§2143.02. Due to the omission of each of the three essential elements for an obviousness rejection (i.e., claim language, motivation to combine, and reasonable expectation of success), three separate reasons exist for no rejection. Even if a rejection is maintained or raised, final rejection is premature.

C. General Comments on Dependent Claims

Since each of the dependent claims depends from a base claim that is believed to be in condition for allowance, Applicant believes that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. However, Applicant does not necessarily concur with the interpretation of the dependent claims as set forth in the Office Action, nor does Applicant concur that the basis for the rejection of any of the dependent claims is proper. Therefore, Applicant reserves the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

D. Conclusion

In general, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant : Andrew H. Pritchard  
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In view of the foregoing amendments and remarks, Applicant respectfully submits that the application is in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Applicant's undersigned attorney can be reached at the address shown below. All telephone calls should be directed to the undersigned at (857) 413-2056.

Respectfully submitted,

Date: August 31, 2007

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